

REMARKS

Please reconsider the present application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering the present application.

I. Disposition of the Claims

Claims 1-30 are currently pending in the present application. Moreover, by way of this reply, claims 1, 14, and 15 have been amended only for purposes of clarification.

II. Rejection(s) under 35 U.S.C. § 103

As an initial matter, it is noted that the Office Action relies on no less than seven references for collectively rejecting the pending claims under 35 U.S.C. § 103. Even more troubling is that claims 4, 5, 7, 8, 11, 13, 17, 18, 20, 21, and 24 were each rejected based on a combination of four different references, and claim 12 was rejected based on a combination of five different references. Such dependence on a large number of references must be supported by a showing that one of ordinary skill in the art would have reason to turn to each of the various cited references to arrive at the claimed invention without having the present application as a guide. The Examiner “cannot use hindsight reconstruction to *pick and choose* among isolated disclosures in the prior art to deprecate the claimed invention.” See *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) (emphasis added). Thus, Applicant respectfully requests that Examiner not “pick and choose” disparate teachings from a large number of different references and simply combine them together with the aim of showing all the claimed limitations, but instead combine them because one skilled in the art would find it desirable to do so, not only because the art is

purportedly analogous. *See In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (instructing that the proper inquiry is not whether referenced can be combined or modified, but rather whether the references suggest the desirability of the combination); MPEP § 2143.01.

Claims 1-3, 6, 9, 10, 15, 16, 19, 22, 23, 25, and 26

Claims 1-3, 6, 9, 10, 15, 16, 19, 22, 23, 25, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,628,939 (“Paulsen”) and U.S. Patent No. 6,778,820 (“Tendler”) in view of U.S. Patent No. 6,508,710 (“Paravia”). For the reasons set forth below, these rejections are respectfully traversed.

In order to establish a *prima facie* case of obviousness, the Examiner must show (i) some suggestion or motivation, either in the references themselves or based on knowledge of one of ordinary skill in the art, to modify the reference or to combine reference teachings, (ii) a reasonable expectation of success, and (iii) that the references when combined teach or suggest all the claim limitations. *See* MPEP § 2143. As shown below, the Examiner has failed to meet this burden.

Independent claim 1 (as amended) in part requires that the player device commence game play by receiving an activation signal on the condition that the device’s location is within a bounded authorized area. Independent claim 15 (as amended) in part requires the player device is activated to receive game play data if an established physical location of the player device corresponds to an authorized gaming area. Thus, independent claims 1 and 15 require that a player (or gaming) device be activated to commence game play or receive game play data upon location verification of the player device. Paulsen, Tendler, and Paravia fail at least to disclose or suggest these limitations.

The Office Action specifically states that Paulsen and Tendler fail to disclose “commenc[ing] game play by causing an activation signal to be received and processed.” Paravia, with reference to Figure 11, discloses “provid[ing] player interface 114 via standard Internet connection 1102 while reserving actual wagering via direct communication link 1104 after player location verification.” *See* Paravia, column 19, lines 1 – 5 (emphasis added). The player interface 114 is “the ‘front end’ of the automated gaming system that provides information and data-entry screens to the one or more players 118 accessing gaming server 104.” *See id.* at column 6, lines 51 – 55. Thus, Paravia discloses communication for allowing a player using a computer system to access a remote player interface (e.g., a website), which can be used for gaming once the player’s location is verified. In other words, in Paravia, a player at his/her computer accesses the Internet to navigate to the remote player interface and is then allowed to “gamble” on the player interface once his/her computer’s location has been verified. The player’s computer is never activated; the player commences game play by simply logging onto the remote web-hosted player interface. *There is no activation of a player device.* Accordingly, Paravia fails to disclose activating a location-verified player device as required by independent claims 1 and 15.

Further, there is no motivation or suggestion to combine the teachings of Paulsen, Tendler, and Paravia. Paulsen discloses a personal gaming device for allowing a player to participate in a game other than at a fixed location. *See* Paulsen, column 10, lines 24 – 26. Tendler discloses a wireless phone that has a global positioning system (GPS) receiver used for verifying the location of the phone when a telephone wager is made using the phone. *See* Tendler, Abstract. Paravia discloses a gaming service that verifies a player’s location based on

an address of a personal computing device used to access a network on which a player interface for gaming is accessible. *See* Paravia, column 27, line 28 – column 28, line 3.

One of ordinary skill in the art presented with Paulsen, which is directed to personal gaming devices with no suggestion of verifying locations of such devices, would find no reason to turn to Tendler or Paravia, which are both completely silent as to any sort of personal gaming device (noting that in Paravia, a player has to access a remote interface for gaming). Further, one of ordinary skill in the art presented with Tendler, which is completely silent as to any sort of gaming device altogether, would find no reason to turn to Paulsen or Paravia, which are concerned with providing a player with gaming services via a personal gaming device or personal computer. Further still, one of ordinary skill in the art presented with Paravia, which is directed to computer network gaming, would find no reason to turn to Paulsen or Tendler, which are both completely silent as to gaming over a computer network (e.g., the Internet). The mere fact that Paulsen, Tendler, and Paravia may be technically combined or modified does not render the resultant combination obvious; Paulsen, Tendler, and Paravia must suggest *the desirability* of the combination. *See In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (emphasis added); MPEP § 2143.01. The Examiner's mere remark that Paulsen, Tendler, and Paravia are combinable because they are all analogous art (gaming) is insufficient for showing a motivation or suggestion to combine the references in any combination.

In view of the above, Paulsen, Tendler, and Paravia, whether considered singly or in any combination, fail to disclose the invention recited in independent claims 1 and 15. Further, Paulsen, Tendler, and Paravia are not properly combinable under § 103. Thus, independent claims 1 and 15 are patentable over Paulsen, Tendler, and Paravia. Dependent claims 2, 3, 6, 9, 10, 16, 19, 22, 23, 25, and 26 are allowable for at least the same reasons. Accordingly,

withdrawal of the § 103 rejections is respectfully requested.

Claims 27-30

Claims 27-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Paulsen and Tendler in view of U.S. Patent No. 6,527,638 (“Walker”). For the reasons set forth below, these rejections are respectfully traversed.

As discussed above, Paulsen and Tendler fail to disclose all the limitations of independent claim 15. Walker similarly fails. Particularly, Walker, which discloses a gaming system for allowing a player to gamble from a remote location (*see* Walker, Abstract), is completely silent as to activating a location-verified gaming or player device. Thus, Walker fails to disclose those limitations of independent claim 15 not disclosed or taught in Paulsen and Tendler.

In view of the above, Paulsen, Tendler, and Walker, whether considered singly or in any combination, fail to disclose the invention recited in independent claim 15. Thus, independent claim 15 is patentable over Paulsen, Tendler, and Walker. Dependent claims 27-30 are allowable for at least the same reasons. Accordingly, withdrawal of the § 103 rejections is respectfully requested.

Claims 4, 5, 7, 8, 17, 18, 20, and 21

Claims 4, 5, 7, 8, 17, 18, 20, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Paulsen, Tendler, and Paravia in view of U.S. Patent Application Publication No. 2002/0168967 (“Clapper”). For the reasons set forth below, these rejections are respectfully traversed.

As discussed above, Paulsen, Tendler, and Paravia fail to disclose all the limitations of independent claims 1 and 15. Clapper similarly fails. Particularly, Clapper, which discloses establishing a wireless retail customer intranet (*see* Clapper, Abstract), is completely silent as to activating a location-verified gaming or player device. Thus, Clapper fails to disclose those limitations of independent claims 1 and 15 not disclosed or taught in Paulsen, Tendler, and Paravia.

In view of the above, Paulsen, Tendler, Paravia, and Clapper, whether considered singly or in any combination, fail to disclose the invention recited in independent claims 1 and 15. Thus, independent claims 1 and 15 are patentable over Paulsen, Tendler, Paravia, and Clapper. Dependent claims 4, 5, 7, 8, 17, 18, 20, and 21 are allowable for at least the same reasons. Accordingly, withdrawal of the § 103 rejections is respectfully requested.

Claims 11, 13, and 24

Claims 11, 13, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Paulsen, Tendler, and Paravia in view of U.S. Patent No. 6,470,180 (“Kotzin”). For the reasons set forth below, these rejections are respectfully traversed.

As discussed above, Paulsen, Tendler, and Paravia fail to disclose all the limitations of independent claims 1 and 15. Kotzin similarly fails. Particularly, Kotzin, which discloses a wireless system for communicating data to a handheld wireless device (*see* Kotzin, Abstract), is completely silent as to activating a location-verified gaming or player device. Thus, Kotzin fails to disclose those limitations of independent claims 1 and 15 not disclosed or taught in Paulsen, Tendler, and Paravia.

In view of the above, Paulsen, Tendler, Paravia, and Kotzin, whether considered singly or

in any combination, fail to disclose the invention recited in independent claims 1 and 15. Thus, independent claims 1 and 15 are patentable over Paulsen, Tendler, Paravia, and Kotzin. Dependent claims 11, 13, and 24 are allowable for at least the same reasons. Accordingly, withdrawal of the § 103 rejections is respectfully requested.

Claim 12

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Paulsen, Tendler, Paravia, and Kotzin in view of U.S. Patent No. 6,650,892 (“Thiriet”). For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Paulsen, Tendler, Paravia, and Kotzin fail to disclose all the limitations of independent claim 1. Thiriet similarly fails. Particularly, Thiriet, which discloses a technique for playing games on a cellular telephone (*see* Thiriet, Abstract), is completely silent as to activating a location-verified gaming or player device. Thus, Thiriet fails to disclose those limitations of independent claim 1 not disclosed or taught in Paulsen, Tendler, Paravia, and Kotzin.

In view of the above, Paulsen, Tendler, Paravia, Kotzin, and Thiriet, whether considered singly or in any combination, fail to disclose the invention recited in independent claim 1. Thus, independent claim 1 is patentable over Paulsen, Tendler, Paravia, Kotzin, and Thiriet. Dependent claim 12 is allowable for at least the same reasons. Accordingly, withdrawal of the § 103 rejection is respectfully requested.

Claim 14

Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kotzin and

Tendler in view of Paravia. For the reasons set forth below, this rejection is respectfully traversed.

Independent claim 14 (as amended) in part requires that the gaming device be activated for game play only when its physical location is within a gaming authorized region. As discussed above, Kotzin, Tendler, and Paravia each fail to disclose activating a location-verified gaming device. Thus, independent claim 14 is patentable over Kotzin, Tendler, and Paravia. Accordingly, withdrawal of the § 103 rejection is respectfully requested.

III. Conclusion

The Examiner is encouraged to contact the undersigned attorney if it would be beneficial to further advance the prosecution of the application.

Please apply any charges not covered, or any credits, to Deposit Account 19-2555 (Reference No. 24207-11488).

Respectfully Submitted,
Ryan S. Steelberg

Date: APRIL 21, 2006 By: Wasif H. Qureshi

Wasif H. Qureshi, Attorney of Record
Registration No. 51,048
FENWICK & WEST LLP
801 California Street
Mountain View, CA 94041
Phone: (650) 335-7121
Fax: (650) 938-5200